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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/801,401

03/15/2004

Jehan Clements

02013-06034s

1672

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7590

03/04/2009

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EXAMINER

GISHNOCK, NIKOLAI A

ART UNIT

PAPER NUMBER

3715

MAIL DATE

DELIVERY MODE

03/04/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/801,401	<b>Applicant(s)</b> CLEMENTS, JEHAN	
	<b>Examiner</b> Nikolai A. Gishnock	<b>Art Unit</b> 3715	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-29 and 31-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-29 and 31-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/15/2004 & 11/28/2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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## DETAILED ACTION

In reply to Applicant's response, filed 11/7/2008, claims 1-20, 25, 30, & 35 are cancelled. Claims 21-24, 26-29 & 31-34 are pending.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 21-24 & 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzales (US 2002/0161603 A1), hereinafter known as Gonzales, and further in view of Scocca (US 6,126,202 A), hereinafter known as Scocca, Clements (US 6,210,172 B2), hereinafter known as Clements '172, and Schubert (US 5,127,879 A), hereinafter known as Schubert.

4. Gonzales teaches a storytelling book and method of providing a storytelling book (interactive publishing system, Para. 0032; method, Para. 0043-44), comprising: operating a software program in a computer (computer system, Para. 0037) having subroutines for (a) accepting a first set of inputs from a user in a first graphical user interface screen and providing

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them to the software program (an Author can create an article, etc., Para. 0068-78), the first set of inputs comprising title information (Figure 6, Item 610), author information (Figure 6, Item 605), and one or more clip-art images (Figure 6, Items 635 & 640); automatically generating a cover page for printing on a first leaf's front-side from the first set of inputs using said software program (The content management application then displays the images and text arranged in the layout of the selected template, Para. 0194), wherein the cover page includes at least one of title information, author information, and one or more clip-art images (Para. 0181-193); accepting a second set of inputs from the user in a second graphical user interface screen and providing them to said software program, the second set of inputs comprising one or more clip-art images (To manage a collection of images in an image library: Point and click the visual assets button, Para. 0206-207) and corresponding text (To Edit an Article: Identify the article's page name in the Name column and click the corresponding edit button in the Function column, Para. 0196-197, See also Figure 7); automatically generating, using said software program, a title page for printing on the first leaf's back-side and a second leaf's front-side, a first story page from the one or more clip-art images from the second set of inputs and a second story page from the second set of inputs including the one or more clip-art images and the corresponding text for printing on a third leaf's front-side (Click a submit button to view the edited article. At this point the article is laid out in accordance with the template that the Author used to create the article, Para. 0209) for printing on the second leaf's back-side and automatically proportionally enlarging the one or more clip-art images from the second set of inputs on the first story page to a maximum size that does not overlap margins of the first story page (In content management and database applications, a template is a blank form that shows which fields exist, and the locations and sizes of the fields. Fields are populated by database-managed text and media that are displayed in a layout determined by the template. A content component of an article can be

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any of text, a link (text based or image based), or an asset (e.g., image, sound, video, animation). An element of a template is a defined space within which a content component is rendered, i.e., positioned and displayed, or in the case of an active content component such as an audio clip, executed, Para. 0050-51; it is understood that the templates shown in Figure 2 automatically adjust clip art to fit within margins), and allowing the user to print, using the software program, the cover page, the title page, and the first and second story pages (Print module is for producing a hard copy of the published material. It can include, for example, a browser-based application for creating print on demand marketing and business communications, Para. 0117) [Claims 21 & 26].

5. What Gonzales fails to teach is *where the published book is a story book* and wherein the title page includes the title and author information; wherein the title page, and first and second story pages include one or more indicia for indicating how to assemble the second story page; and wherein the first story page and second story page are printed for binding [Claims 21 & 26]. However, Scocca teaches a *storybook publishing kit for children*, wherein the title page includes title and author information (As can be seen the cut out section of the cover drawing template is centered so that the drawings will appear in the center of the cover drawing sheet. The area below the arrow on the cover drawing page is where the text will be reprinted from a designated box on the text page form for the cover drawing sheet indicating the title of the book, the author and to whom if anyone the book is being given as a gift, 3:32-39), instructional indicia for indicating how to assemble the book (FIG. 1 is an illustration of the instruction sheet in which the contents of the invention the book publishing kit is listed. The contents of the invention include: a template for the pages of the book; a template for the cover sheet of the book; text pages, preferably three and preferably on yellow paper, for writing the text for each page. two cover drawing sheets or pages with the extra cover sheet provided for mistakes or changes;

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sheets for the book pages; one set of washable markers; an order form; an illustration or visual sheet which provides information and instruction to the user on how the book will be bound and published as shown in FIG. 8, 2:13-31), and a method of printing the book for binding (Once the pages are drawn and the text written in the boxes of the text page the material can be mailed back to the publisher in pre-addressed envelope included with the kit. The publisher will then match the drawings with the text and print and bind the book. By using templates, the preparation of the book pages and cover drawing sheet is easier and more fun for a child. The completed bound book is mailed back to the home of the child within a number of weeks, 3:40-48). The book publishing templates of the system and method of Gonzales would be adapted to generate a book with the features demonstrated by Scocca, such as generating title page information, such as the title and author of the book, which are old and well-known in the publishing industry. The templates taught by Gonzales would also be adapted to provide a page bearing publishing instructions, such as is taught by Scocca, which is useful to an amateur author attempting to publish an illustrated storybook. Further, the printing function of Gonzales would be reasonably adapted to alternatively allow a user to print the book for binding, if the user possessed a printer and did not wish to mail the manuscript, such as when a small number of copies are required. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have adapted the publishing templates of Gonzales to include the title and author information on the title page; wherein the title page, and first and second story pages include one or more indicia for indicating how to assemble the second story page, as taught in Scocca; in order to assist an amateur author in publishing a professional-looking storybook; and to adapt the printing system and method of Gonzales to allow a user to print the first story page and second story page for binding, taught by Scocca, in order to allow

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an amateur publisher to print and bind "proof" or "draft" copies of a storybook themselves, without requiring outside assistance or additional postage [Claims 21 & 26].

6. What Gonzales and Scocca fail to explicitly teach is where the cover page, title page, first story page, second story page, and third story page are oriented in diametric contraposition [Claims 21 & 26]. However, Clements '172 teaches a storytelling book composed of a first or facing side of an "a" side set of pages including a graphic or illustration of a portion of a story, with the "a" sides together and successively illustrating the story, without words and printed text, and a second or back side of a "b" side set of pages including the graphics and illustrations being identical or closely corresponding to the facing {"a" side} graphic or illustration (4:11-30). This page arrangement is understood to be "in diametric contraposition". The publishing templates of the system and method for of Gonzales would be used to produce the storybook, having an "a" set of pages including identical or closely corresponding graphics and illustrations as a "b" set, but not including the corresponding words or printed text, of Clements '172.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the templates taught by Gonzales to produce the storytelling book having diametrically opposed story pages, having sets of pages with identical illustrations but with one set omitting the narrative, as taught by Clements '172, in light of the teachings of Scocca, in order to easily allow a user to specify, preview, and remotely produce the storybook document in volume [Claims 21 & 26].

7. What Gonzales, Scocca, and Clements '172 fail to teach is where the title page includes copyright information [Claims 21 & 26]. However, Schubert teaches a recordkeeping book having worksheets for assisting a user in filling in personal information (4:47-52) and step-by-step instructions for completion (1:38-40). Schubert teaches where the front surface of the page is imprinted with general information about the use of the book, including a copyright notice

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(6:67-7:8). The book publishing templates of the system and method of Gonzales would be adapted to generate a book with copyright information taught by Schubert, which is also old and well-known in the publishing industry. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have added the copyright information to the title page template of Gonzales, as taught by Schubert, further in light of the teachings of Scocca and Clements '172, in order to assist an amateur author in publishing a professional-looking storybook [Claims 21 & 26].

8. What Gonzales further fails to teach is wherein said one or more indicia include binding instructions [Claims 22, 27, & 32]. However, Scocca teaches instructional indicia for indicating how to assemble the book (2:13-31), and a method of printing the book for binding using templates (3:40-48). The book publishing templates of the system and method of Gonzales would be adapted to provide a page bearing binding instructions, such as is taught by Scocca, which is useful to an amateur author attempting to publish an illustrated storybook, such as when a small number of copies are required. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have adapted the publishing templates of Gonzales to include one or more indicia for indicating how to bind the story pages, as taught in Scocca, in light of the teachings of Clements '172 and Schubert, in order to assist an amateur author in publishing a professional-looking storybook, without requiring outside assistance or additional postage [Claims 22, 27, & 32].

9. What Gonzales further fails to teach is wherein said one or more indicia include page numbers [Claims 23, 28, & 33]. However, Scocca teaches where page indicium includes numbering (Figure 6, Item 49). The page numbering of Scocca would be used in the software publishing program templates of Gonzales so that the appropriate box of the text page form can be matched for placing the text with the correct page for illustration, and also to place the pages



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in the correct order for binding the book. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have included page number indicia on the pages of the book templates in the system and method of Gonzales, as taught by Scocca, in light of the teachings of Clements '172, in order for a user to match a desired piece of clip art and/or text to a given page when authoring a flip-over story book [Claims 23, 28, & 33].

10. Gonzales teaches wherein said one or more indicia include graphical symbols (image assets, Para. 0051; understood to be graphics) [Claims 24, 29, & 34].

11. Claims 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzales, Scocca, Clements '172, and Schubert, as applied to claims 21 & 26 above, and further in view of Schach et al. (US 5,397,156 A), hereinafter known as Schach.

12. Gonzales, Scocca, Clements '172, and Schubert teach all the features of claims 21 & 26 as demonstrated above. Gonzales teaches a system and method for producing a storytelling book, comprising a software program in a computer (Para. 0032-44). Scocca teaches a kit for producing a storytelling book, including instructions for binding (2:13-31 and 3:40-48). Clements '172 teaches where the pages of the book are assembled in diametric contraposition (4:11-30). What Gonzales, Scocca, Clements '172, and Schubert fail to teach is where the kit includes a front cover that houses the printed cover page and binds with the printed title page, the first story page, the second story page, and a back cover [Claim 31]. However, Schach teaches a kit for publishing a personalized paperback romance novel, including a front cover that houses a printed title page, and having author, title, and instruction information indicia thereon (3:12-31 and 4:33-48; see also Figures 1 & 2). The kit including a front cover of Schach would be used to bind, in the fashion taught by Scocca, the pages generated and printed with the templates

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taught by Gonzales, in order to provide a cover that is otherwise difficult to print or photocopy, e.g. one having an unusual cover, watermark, or printed design in reddish-purple ink, because the book would be more durable and professional looking if special cover paper is supplied with the kit. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, for the kit to include a front cover that houses the printed cover page and binds with the printed title page, the first story page, the second story page, and a back cover, as taught by Schach, with a software program in a computer for publishing the book, as taught by Gonzales, in light of the teachings of Scocca, Clements '172, and Schubert , in order to provide specialized, more durable paper to use for the cover of a storybook [Claims 31-34].

### ***Response to Arguments***

13. Applicant's arguments filed 11/7/2008, see pages, have been considered but are not persuasive.

14. In regards to Applicant's remarks that Gonzales teaches only publishing software, and fails to teach where the generated book is a story book, Examiner notes that Gonzales is not relied upon to teach the limitation. Instead, Scocca teaches this at Para. 0032-44. It would have been obvious to use a web publishing system such as Gonzales' to publish any type of book, including children's story books. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

15. In response to Applicant's argument that Gonzales does not disclose "the first set of inputs," because an "article name or page name" is not "author information"; an "article title" -- in the web page context - is the <TITLE> tag in HTML, which relates to the title of the specific

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page (or "article"), not the title of the entire work; in the web-page context or any other, a string of text comprising author, title, or copyright information, etc. is merely non-functional printed matter, and having no tie in function to the substrate, is not patentably distinguished over the prior art. It would be obvious to merely provide the relevant publication data via HTML tags for a web-based publishing software such that it is printed in the traditional manner on the first inside leaf of the book. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983). USPTO personnel need not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate. See also *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004) and MPEP 2106.01.

16. With regard to Applicant's arguments at pages 13-14 that Scocca fails to teach one or more indicia for indicating how to assemble the pages in diametric contraposition, Clements '172 at (6:27-48) teaches:

**In order to create a storytelling book in accordance with the invention, a corresponding insertion page having a picture, and preferably some text as well, corresponding to the picture on the original insertion page is generated either manually or mechanically (e.g., using a photocopier or a graphical computer program). This step of generating a series of corresponding insertion pages having corresponding pictures and text is most preferably done by having the creator of the story write the text on a corresponding lined insertion page provided with the book. Most preferably, this lined corresponding insertion page has two columns of dotted lines with the instructions "Write your story using these lines" noted in parentheses at the top of the page. On this lined corresponding insertion page, a space without lines is provided in the lower right-hand corner with the instructions, "Paste a reduced size copy of your picture here" noted in the space. A reduced-size picture corresponding to the picture on the original insertion page may be created either manually or mechanically, and then pasted in the indicated space. Alternatively, the corresponding picture may be of any size, and may be considered the corresponding insertion page itself.**

17. Thus, the rejection under 35 USC §103 does not rely upon Scocca to teach this limitation, as Clements '172 teaches providing instructions for assembling the book pages in diametric contraposition as indicia in the story book.

18. Applicant's arguments further directed to Clements '172 are not persuasive. The courts have held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. See *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

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19. Applicant arguments with regard to the Schubert reference are also not persuasive because one of ordinary skill in the art would clearly understand copyright information on the first leaf of a book to refer to the copyright date of the book, not of a software program used to generate the book. See applicant's Figure 2, Item 200; in this case, (c) 2004 Jehan Clements refers to the author of the story, not of the software used to generate the book.

20. Applicant's arguments with regard to Schach are also irrelevant as Clements '172 is used to demonstrate a teaching of the page orientation being "in diametric contraposition" (i.e., opposite to one another). See paragraph 6 above. The publishing templates of the system and method for of Gonzales would be used to produce the storybook, having an "a" set of pages including identical or closely corresponding graphics and illustrations as a "b" set, but not including the corresponding words or printed text, of Clements '172, in order to easily allow a user to specify, preview, and remotely produce the storybook document in volume, that is, the positioning of the pages would be merely determined in advance to facilitate printing. The content of the indicia of the pages is not a distinguishing basis for patentability. *Gulack, Id.*

21. With regard to applicant's arguments that examiner has not made a *prima facie* case of patentability due to failure to provide adequate reasons to combine the cited references, see pages 16-19, applicant's emphasis added remarks highlight examiner's explicit and sufficient rationale for combining the references. In this case, one would want to combine improvements from Scocca, Clements, Schubert and Schach with the base invention of Gonzales in order to receive the well-known and expected benefits applicable to book publishing (e.g., proofing, preview, professional touches, hard covering). As such, examiner provides for A in view of B; A in view of X, and A in view of Y, etc. in terms of the recited limitations. As such, applicant has not proffered specifically where examiner's rationale is in error. The focus when making a determination of obviousness should be on what a person of ordinary skill in the pertinent art

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would have known at the time of the invention, and on what such a person would have been reasonably expected to have been able to do in view of that knowledge. This is so regardless of whether the source of that knowledge and ability was documentary prior art, general knowledge in the art, or common sense. See MPEP 2142 (Rev. 6, Sept. 2007). *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. \_\_\_, 82 USPQ2d at 1385 (2007). For the above reasons, examiner's position is that a proper *prima facie* case of obviousness has been made in the above action.

### **Conclusion**

22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikolai A. Gishnock whose telephone number is (571)272-1420. The examiner can normally be reached on M-F 8:30a-5p.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

2/21/2009  
/N. A. G./  
Examiner, Art Unit 3715

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